

REMARKS

This is a response to the Office action dated April 16, 2007. Applicant adds new claims 39-41 and amends claims 1-2. Claims 1-8 and 31-41 are presented for examination. Applicant requests reexamination and reconsideration of application.

On page 2 of the Office action, the Examiner confirms removing finality because of the RCE and submission filed on March 9, 2007.

On pages 2-4 of the Office action, the Examiner states he considered applicant's arguments with respect to claims 1-8 and 31-38 but finds them moot due to the new grounds of rejection to be discussed below.

On page 4 of the Office action, the Examiner agrees that claims 1-8 find support in US Patent No. 5,978,836, filed on July 28, 1997, and withdraws the rejections of claims 1-8 based on Project 2000.

Applicant understands US Patent No. 5,978,836 also supports the amendment to the specification regarding the sequencer since the Office no longer maintains this objection to the specification.

On page 5 of the Office action, the Examiner rejects claims 1-8, 31, 33-35, and 37-38 on the ground of nonstatutory obviousness-type double patenting over claim 2 of US Patent No. 5,978,836 to Ouchi (Ouchi).

Amended claim 1 patentably distinguishes over claim 2 of Ouchi, because claim 2 of Ouchi fails to describe a form route manager that includes an out-box adapted to send the email without the route to the next email address as recited in amended claim 1.

Amended claim 2 patentably distinguishes over claim 2 of Ouchi, because claim 2 of Ouchi fails to describe a form route manager for managing a project to role to email address table as recited in amended claim 2.

1 Claims 3-8 and 31 depend from claim 1 or claim 2 and patentably distinguish over claim
2 2 of Ouchi for the same reasons presented with respect to claim 1 and claim 2 as well
3 for the additional limitations each dependent claim recites.

4 Claims 33-35 and 37-38 depend from claim 31 or claim 32 and patentably distinguish
5 over claim 2 of Ouchi for the same reasons presented in connection with claim 31 and
6 claim 32 as well as separately for the additional limitations each dependent claim
7 recites.

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9 On pages 5-6 of the Office action, the Examiner rejects claim 1 under 35 USC 102(b) as
10 being anticipated by US Patent No. 5,125,075 to Goodale et al. (Goodale).

11 The Examiner contends that Goodale discloses the workflow system of claim 1 based
12 on col. 1, lines 67 - col. 2, lines 20 and col. 4, lines 38-52.

13
14 Because Goodale fails to describe (1) a first sequencer adapted to compare a step field
15 of the email with the route, define the next email address based on the compare, update
16 the email address to the next email address, update the step field to the next step and
17 (2) an out-box adapted to send the email without the route to the next email address,
18 Goodale cannot anticipate amended claim 1.

19 Referring to examiner's citations, Goodale fails to describe a first sequencer that
20 operates on a step field of an email. Instead Goodale describes an electronic mail
21 circulation device that enables a sender to establish a circulation list (prospective
22 recipients selected by the sender) and associate an item with the circulation list to form
23 a unique, noninterchangeable route package. The circulation list is in the route package
24 which is transmitted to the recipients who receive the route package (col. 1, lines 67 -
25 col. 2, lines 20 and col. 4, lines 38-52). For each recipient, pointers 79 define the next
26 recipient to whom the route package is to be sent and header 75 describes mail item
27 addresses in the route definition file 73 shown in Figure 23 (See Figures 22-24 and cols.
28 14-15 for details).

1 Amended claim 1 captures these differences requiring a workflow system, comprising:
2 a form route manager for receiving and sending email according to a route, the
3 route comprising a step-by-step sequence of email addresses, the form route manager
4 includes:
5 an in-box adapted to receive email;
6 a first sequencer adapted to as follows:
7 compare a step field of the email with the route,
8 define the next email address based on the compare,
9 update the email address to the next email address,
10 update the step field to the next step; and
11 an out-box adapted to send the email without the route to the next email address.

12 Because Goodale teaches circulating the item and the circulation list in a unique,
13 noninterchangeable route package to the recipients, it teaches away from amended
14 claim 1, which would have been nonobvious over Goodale.

15 On pages 6-9 of the Office action, the Examiner rejects claims 32-38 under 35 USC
16 102(b) as being anticipated by "Sams Teach Yourself Microsoft Project 2000 in 24
17 Hours" (Project 2000). The Examiner contends since the software described in Project
18 2000 necessarily functions as claimed, Project 2000 inherently anticipates the claims.
19 The examiner then requests applicant provide proof that Project 2000 does not
20 necessarily or inherently possess the characteristics of the claim invention.

21
22 The examiner has not established a prima facie case that Project 2000 anticipates or
23 renders obvious claims 32-38. Despite requests, the examiner has not provided
24 literature to support his interpretation of Project 2000. MAPI (messaging application
25 programming interface) does not necessitate the claimed functions and Project 2000
26 does not describe the back end of MS Exchange and MS Project. Instead, Project 2000
27 teaches the user interface of Project 2000. The examiner's inherency case extrapolates
28 back end functions from the user interface suggesting the claimed functions are a
29 possibility rather than necessity in Project 2000. Applicant requests the examiner
30

1 Identify literature describing the functions of MS Exchange and MS Project 2000 to
2 assess patentability because otherwise a prima facie case is not established.

3 On page 9 of the Office action, the examiner stated claims 3 and 6-7 are objected to as
4 being dependent upon a rejected base claim, but would be allowable if rewritten in
5 independent form. Applicant adds claims 39-41 corresponding to claims 3, 7, and 6.
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7 Please email reply to schedule an interview to discuss this amendment.
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10 Respectfully Submitted,

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14 Robert Moll

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